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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,713	08/31/2000	Trung T. Doan	93-0421.04	4284
7590	03/11/2004			EXAMINER
Charles Brantley 800 S Federal Way M/S 525 Boise, ID 83716-9632			MACARTHUR, SYLVIA	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/652,713	DOAN, TRUNG T.	
	Examiner	Art Unit	
	Sylvia R MacArthur	1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 July 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 36 and 37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 8/31/2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant views as the invention.

3. Claim 36 recites a splash controller that is "configured to draw said chemical toward said splash controller" and "configured to generate a gas pressure around said edge bead that is lower than an ambient gas pressure." The common applicable definition of "configured" is "shaped," of "draw" is "to cause to move toward," and of "generate" is "to bring into existence." Thus, claim 36 requires that the splash controller be so shaped as to (1) cause the chemical to move toward it and (2) cause a gas pressure lower than an ambient gas pressure to be brought into existence around the edge of the bead.

It is also noted that the term "splash controller" is not present in the specification. However, it is understood that the structure and operation of the invention from the specification, what is recited as the "splash controller" in the claims is "vacuum port 18," an element to which suction is applied to create a "surround vacuum" that "controls solvent and particle splashing during the process of removing the edge bead" and improves the edge profile of the coating material as "the dissolved coating material and excess solvent is suctioned away" therethrough (page 4, lines 5-18).

Furthermore, there is no description of the configuration of the suction ports shown in Figures 1 and 2, but they appear merely to be cylindrical tubes. The second paragraph of 35 U.S.C. 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

One of ordinary skill in the art would deduce from the specification that the "splash controller" recited in the claims is the "vacuum port 18" described in the specification, if for no other reason than there simply is no other element of the disclosed invention to which this could apply. However, from our perspective, one of ordinary skill in the art would not be advised by the specification of what structure of the splash controller is "configured to draw" the chemical toward it and configured to generate" a gas pressure that is lower than ambient (emphasis added in both cases), inasmuch as it would appear that it is the suction applied through the splash controller and not the configuration of the splash controller that accomplishes these tasks. Thus, the metes and bounds of claim 36 not to be determinable. Since the public must be apprised of exactly what a patent covers so that those who would approach the area circumscribed by the claims may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance, claim 36 does not comply with the second paragraph of 35 U.S.C. 112

See In re Hammack 427 F.2d 1378, 1382,166 USPQ 204, 208 (CCPA 1970).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sylvia R MacArthur whose telephone number is 571-272-1438. The examiner can normally be reached on M-F during the core hours of 8 a.m. and 2 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Mills can be reached on 703-308-1633. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sylvia R MacArthur
Patent Examiner
Art Unit 1763

SM 3/5/04